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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | | | | | | | | | |
|--|--------------------------------|--------------------------|------------------|--|--------------------|---|--------------------------------|--|---------------------------|---|---------------|
| <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p> | | Application Number | Filed | | | | | | | | |
| | | 09/836,449 | April 17, 2001 | | | | | | | | |
| | | First Named Inventor | | | | | | | | | |
| | | Stephen J. FONASH | | | | | | | | | |
| | | Art Unit | Examiner | | | | | | | | |
| | | 2812 | Richard A. Booth | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td>_____ Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td>_____ Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. Registration number 58,247</td><td>_____ Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td>_____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p> | | | | <input type="checkbox"/> applicant/inventor. | _____ Signature | <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | _____ Typed or printed name | <input checked="" type="checkbox"/> attorney or agent of record. Registration number 58,247 | _____ Telephone number | <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | _____ Date |
| <input type="checkbox"/> applicant/inventor. | _____ Signature | | | | | | | | | | |
| <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) | _____ Typed or printed name | | | | | | | | | | |
| <input checked="" type="checkbox"/> attorney or agent of record. Registration number 58,247 | _____ Telephone number | | | | | | | | | | |
| <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ | _____ Date | | | | | | | | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-------------------------------------|---|----------------------------|
| In re Application of: |) | Group Art Unit: 2812 |
| |) | |
| Stephen J. FONASH, <i>et al.</i> |) | Confirmation: 7746 |
| |) | |
| Application No.: 09/836,449 |) | Examiner: Richard A. Booth |
| |) | |
| Filed: April 17, 2001 |) | |
| |) | |
| For: DEPOSITED THIN FILMS AND THEIR |) | Date: October 30, 2006 |
| USE IN SEPARATION AND SACRIFICIAL) |) | |
| LAYER APPLICATIONS |) | |

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request formal review of the July 28, 2006, Final Office Action. The Examiner has clearly maintained improper rejections under 35 U.S.C. § 103 over a reference to Kalkan et al., which does not qualify as prior art, to the claimed invention. Thus, the outstanding Final Office Action includes clearly improper rejections based upon error(s) in fact which should be overturned, and the Examiner has failed to establish a *prima facie* case of obviousness.

The Examiner has incorrectly applied the article entitled “Nanocrystalline Si Thin Films with Arrayed Void-column Network Deposited by High Density Plasma,” issued to Kalkan et al. (“Kalkan”), as prior art when making the rejections, despite the fact that the article does not qualify as prior art against this application. Specifically, the publication date of the Kalkan reference, i.e. July 1, 2000, is after the effective filing date of this application.

If the Examiner had correctly excluded the Kalkan article from prior art, the current rejections under 35 U.S.C. § 103 would have been unfounded because the Kalkan reference is a key reference relied upon by the Examiner in making each rejection. Applicants otherwise believe this application is in condition for allowance. Thus, Applicants respectfully request that the outstanding rejections based on the Kalkan reference be overturned, and the application be allowed.

This paper is being filed concurrently with a Notice of Appeal and the requisite fee, as required in the guidelines for the New Pre-Appeal Brief Conference Pilot Program published in the July 12, 2005, Official Gazette Notice.

Referring to the pages 2-18 of the outstanding Final Office Action, the Examiner has issued thirteen rejections under 35 U.S.C. § 103 which rely, at least in part, on the Kalkan article. This is the third time this article has been erroneously applied by the Examiner; the Examiner rejected claims based on the Kalkan article in the Office Actions dated June 7, 2004, and April 18, 2005, as well. As Applicants have repeatedly pointed out to the Examiner, this application claims priority under 35 U.S.C. §§ 119(e) and 120 to several provisional and non-provisional applications, including the following applications shown below which were filed prior to the publication of the Kalkan reference, which, as is noted above, was published on July 1, 2000.

| Application No: | Filing Date: |
|---|---------------------|
| 60/215,538 | 06-30-2000 |
| 60/208,197 | 05-31-2000 |
| 09/580,105, now U.S. Patent No. 6,399,177 | 05-30-2000 |
| 60/201,937 | 05-05-2000 |
| 60/197,548 | 04-17-2000 |
| 60/172,840 | 12-20-1999 |

In the response filed December 19, 2005, Applicants provided the Examiner with a detailed claim chart on pages 33-48 specifically pointing out the portions of the priority documents that provide support for pending claims 1-28 and 34-72. The portions of the

priority documents specified by Applicants in the claim chart clearly established an effective filing date of the present application that is prior to the Kalkan reference date of July 1, 2000.

Nonetheless, the Examiner merely asserted on page 18 of the outstanding Final Office Action that the above priority documents do not provide support for the present claims, without providing any reasoning whatsoever for this conclusion. As shown in the Amendments filed November 8, 2004 and December 19, 2005, independent claims 1, 37, and 57, and all those claims dependent therefrom, are clearly supported by these priority documents.

When the claims were last amended in the Amendment filed November 8, 2004, Applicants submitted that the specification provided support for the amendments in at least Figs. 1-13 and related text of the specification. Many of these figures are directly supported by the priority documents, and, in fact, are substantively identical to figures in the priority documents. For example, Figs. 1 and 2 of the present application correspond to Figs. 1 and 2 of U.S. Provisional Application No. 60/208,197, which was filed June 1, 2000, one month prior to the publication of the Kalkan reference. In addition, Figs. 4 and 5 of the present application correspond to Figs. 2 and 3 on pages 12 and 13 of U.S. Provisional Application No. 60/215,538, which was filed June 30, 2000, one day prior to the publication of the Kalkan reference. Similarly, Fig. 7 of the present application corresponds to Fig. 1 of U.S. Provisional Application No. 60/197,548, which was filed on April 17, 2000, three months prior to the publication of the Kalkan reference.

These figures, and related discussions, clearly show support for the subject matter in independent claims 1, 37, and 57, and all claims dependent therefrom, in the priority documents. For example, Figs. 4 and 5 of the present application (i.e. Figs 2 and 3 on pages 12 and 13 of U.S. Provisional Application No. 60/215,538) clearly illustrate depositing a layer of high surface area to volume ratio material having a non-helical columnar structure over a surface of a substrate, and removing at least a portion of said high surface area to volume ratio material layer, as is recited in claim 1. In particular, the second full paragraph on page 2 of U.S. Provisional Application No. 60/215,538 describes the non-helical columnar structure of the deposited layer by disclosing that the “deposited layer has a unique columnar structure and it contains an inherently formed void (i.e., empty space) in between the

columns.” This material has a high surface area to volume ratio because of the spaces created by the columnar structure.

Because these documents so clearly provide support for independent claims 1, 37, and 57, and all claims dependent therefrom, Applicants submit that the Examiner failed to fully consider these priority documents, and improperly stated that these claims were not supported by the priority documents. Thus, the Examiner improperly applied Kalkan as a prior art reference to the claims, and maintained rejections under 35 U.S.C. § 103 that would have otherwise been unfounded.

Applicants submit this Brief and Request a Pre-Appeal Conference to contest this finding by the Examiner because the Examiner has improperly applied the Kalkan article as a prior art reference, despite the fact that Applicants have clearly and convincingly established that the claims are fully supported by priority documents that pre-date the earliest publication of the Kalkan reference.

In view of all of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and prompt notification of the same is earnestly sought.

Respectfully submitted,

Date: October 30, 2006

//Stephen M. Hertzler, Reg. No. 58,247//

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